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| 10/524,371   | 02/10/2005  | Richard Ronald Baynham | 265330US6XPCT       | 4850             |
| 22850  | 7590        | 02/04/2011             |                     |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                        |                     |                  |
| EXAMINER   |             |                        |                     |                  |
| HOOK, JAMES F  |             |                        |                     |                  |
| ART UNIT   |             | PAPER NUMBER           |                     |                  |
| 3754   |             |                        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/524,371

**Applicant(s)**

BAYNHAM ET AL.

**Examiner**

James F. Hook

**Art Unit**

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-16 and 25-38 is/are pending in the application.
- 4a) Of the above claim(s) 35-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 25-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 35-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they provide method steps which were not required of the article claims and are of different scope and content from those originally filed and examined, and since the first office action all method claims have been canceled from the application, and applicant is not allowed to include a new invention such as the new method being claimed in an RCE as such is not a matter of right, however it should be noted that most steps appear to be found in the Cherrington reference below.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-16, 25, 27, 28, and 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hwang with further evidence provided by Ariannejad. The patent to Hwang discloses the recited the recited prefabricated tubular body 2 for use downhole comprising integral centralizer formations 4 formed as projections molded to the tubular body by using heat and pressure to attach them to the tubular where such are made of curable resins such as thermoplastics, where such can be provided with ceramic particulate filler material, in addition thereto fillers including antistatic agents can be provided, where carbon fibers are fillers used inherently to provide antistatic properties, the limitations of claim 12 appear only to recite method steps which would not change the final product materially of providing a projection that is heat and pressure molded of curing resin onto a pipe, the same is true of claim 13 which merely discloses the apparatus, specifically the mold, that is used to form the projections, both claim 13 and 12 hold no patentable weight on an article claim when such are not materially changing the final product, after forming the projections on the pipe the pipe can be coated with a polyester film which is a resin and coated thereto thereby meeting claims 14-16, the tubular core is placed within other objects by sliding and therefore is capable of permitting rotation as well, and where the projections are formed as ribbing or stand off projections, and a catalyst is provided to the curing resin material. The patent to Hwang discloses all of the recited material, where Hwang discloses the use of antistatic fillers and it is considered old and well known in the art that carbon fibers are used as antistatic fillers in pipes, as evidenced by Ariannejad figure 5 that spacer elements for pipe in pipe embodiments of sucker rods

for use with oil can be formed of specific materials including graphite (which is a form of carbon, col. 14, lines 6-12) powder, chopped glass fibers, ceramic powder, and chopped graphite fibers (col. 2, lines 31-61) where the combination of powder or filaments can be combined with ceramic powder (col. 11, line 67 to col. 12 line 11), therefore it would have been obvious to modify the material in Hwang that discloses antistatic fillers to specifically use a known filler such as carbon fibers to achieve antistatic properties as such would only require routine skill and knowledge in the art to select an appropriate material for its specific use from those known in the art as evidenced by Ariannejad, where it is known from prior art such as Ries that carbon powder and fibers have antistatic properties as well.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16, 25, 27, 28, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang in view of Ariannejad. The reference to Hwang discloses all of the recited structure as set forth above, however, if it is considered that carbon fibers are not inherently antistatic additives then the following rejection is considered pertinent. It would have been obvious to one skilled in the art to provide the ceramic additive in Hwang with carbon fibers as well as suggested by Ariannejad where

such is a known equivalent material used as a filler for resins to improve lubricity where carbon fibers can be used in combination with ceramic powders and carbon powders in spacer elements, especially when using such for wells when it is desired to have the spacer be easier to slide to allow for easier insertion.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang in view of Ariannejad as applied to claims 11-16, 25, 27, 28, and 30-32 above, and further in view of Willis. The reference to Hwang as modified discloses all of the recited structure with the exception of forming the spacer elements in a manner that is helical around the pipe. The reference to Willis discloses that it is old and well known in the art to form spacers of either aligned evenly spaced spacers such as seen in figure 1, or to form them in a helical pattern around the inner pipe as seen in figure 5. It would have been obvious to one skilled in the art to modify the spacers in Hwang as modified to be disposed in a helical manner along the length of the tube as suggested by Willis where such would insure proper spacing along the length and such is a known equivalent manner to dispose the spacers in a pipe in pipe situation.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang in view of Ariannejad as applied to claims 11-16, 25, 27, 28, and 30-32 above, and further in view of Bergstrom. The reference to Hwang as modified discloses all of the recited structure with the exception of providing an initiator to the curing resin. The reference to Bergstrom discloses that it is old and well known in the art to provide curing

plastics using catalysts and used in combination with pipes with an initiator as well. It would have been obvious to one skilled in the art to modify the curing resin in Hwang as modified by providing an initiator as well in addition to the catalyst as suggested by Bergstrom as such is old and well known in the art of curing resins used for pipes to provide initiators to insure proper cure and attachment of the resin to the pipe.

Claims 11-16, 25, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherrington in view of Ariannejad. The reference to Cherrington discloses the recited the recited prefabricated tubular body 23 for use downhole wells comprising integral centralizer formations 25 formed as projections molded to the tubular body by using heat and pressure to attach them to the tubular where such are made of curable resins such as thermoplastics and molds are used to form the proper shape, where such can be spaced along the pipe at desired intervals, the limitations of claim 12 appear only to recite method steps which would not change the final product materially of providing a projection that is heat and pressure molded of curing resin onto a pipe, the same is true of claim 13 which merely discloses the apparatus, specifically the mold, that is used to form the projections, both claim 13 and 12 hold no patentable weight on an article claim when such are not materially changing the final product, after forming the projections on the pipe the pipe can be coated with a resin and coated thereto thereby meeting claims 14-16, the tubular core is placed within other objects by sliding and therefore is capable of permitting rotation as well, and where the projections are formed as ribbing or stand off projections. The patent to Cherrington discloses all of

the recited material with the exception of providing the spacer with fillers such as chopped carbon fibers and ceramic particulate material. It would have been obvious to one skilled in the art to provide the spacers in Cherrington with chopped carbon fibers as well as ceramic particulate material suggested by Ariannejad where such is a known equivalent material used as a filler for resins to improve lubricity where carbon fibers can be used in combination with ceramic powders and carbon powders in spacer elements, especially when using such for wells when it is desired to have the spacer be easier to slide to allow for easier insertion.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherrington in view of Ariannejad as applied to claims 11-16, 25, and 30-34 above, and further in view of Willis. The reference to Cherrington as modified discloses all of the recited structure with the exception of forming the spacer elements in a manner that is helical around the pipe. The reference to Willis discloses that it is old and well known in the art to form spacers of either aligned evenly spaced spacers such as seen in figure 1, or to form them in a helical pattern around the inner pipe as seen in figure 5. It would have been obvious to one skilled in the art to modify the spacers in Cherrington as modified to be disposed in a helical manner along the length of the tube as suggested by Willis where such would insure proper spacing along the length and such is a known equivalent manner to dispose the spacers in a pipe in pipe situation.



Claims 27-29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherrington in view of Ariannejad as applied to claims 11-16, 25, and 30-34 above, and further in view of Bergstrom. The reference to Cherrington as modified discloses all of the recited structure with the exception of providing an initiator and thermal catalyst to the curing resin. The reference to Bergstrom discloses that it is old and well known in the art to provide curing plastics with thermal catalysts and initiators when used in combination with pipes. It would have been obvious to one skilled in the art to modify the curing resin in Cherrington as modified by providing an initiator as well as a thermal catalyst as suggested by Bergstrom as such is old and well known in the art of curing resins used for pipes to provide initiators and thermal catalysts to insure proper cure and attachment of the resin to the pipe.

### ***Response to Arguments***

Applicant's arguments with respect to claims 11-16, and 25-34 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/  
Primary Examiner, Art Unit 3754

JFH